



Docket 81695MGB
Customer No. 01333

2622
CW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Robert E. Zeman

METHOD AND APPARATUS FOR
REPRODUCING AN IMAGE WITH
EMBEDDED CUTTING
INSTRUCTIONS AND PRODUCT
THEREOF

Serial No. 09/725,660

Filed 29 November 2000

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Group Art Unit: 2622

Examiner: Mark R. Milia

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Gina Marie Schmitt
Gina Marie Schmitt

May 25 2005
Date

Transmitted herewith is an amendment in the above-identified application:

<input checked="" type="checkbox"/>	No additional fee is required.					
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	(Col. 1)		(Col. 2)	(Col. 3)	OTHER THAN A SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		* HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL	25	MINUS	25	0	X 50	\$0
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<input type="checkbox"/>	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM				+ 360	\$0
					TOTAL	\$0

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☒ Any additional filing fees required under 37 CFR 1.16.

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(For Extensions of Time and other Petitions to the Assistant Commissioner)

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.



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Mailstop: Amendments
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Sir:

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Request for Reconsideration

The Office Action dated March 23, 2005 has been received and reviewed by the applicant. Claims 1-25 are in the application and stand rejected under 35 USC §103(a) as being unpatentable over US Patent No. 6,772,661 to Mikkelsen, et al in view of US Patent No. 5,859,920 to Daly et al.

Independent Claims 1, 12, 13, 21 and 23 relate, among other features, to the provision of cutting instructions that are embedded within a pictorial image that has been printed on a sheet to be cut. So as to not interfere with the viewing of the images, the cutting instructions are rendered invisible such as by the methods taught by Daly et al. One advantage of providing the cutting instructions within the images themselves is that the instructions will be available to any cutting apparatus to which the sheet is provided as long as the cutting apparatus has the means to decode and use the instructions. Only the sheet need be presented to the cutting apparatus; no separate software need accompany the sheet because all of the instructions are on the sheet.

In rejecting Claim 1, the Examiner mistakenly characterizes Mikkelsen as “providing information for cutting the sheet with the printed pictorial image” and printing “the pictorial image on the sheet with cutting instructions.” The Examiner goes on to propose that Mikkelsen discloses “the cutting instructions being dispersed within the pictorial image....” For the reasons set forth immediately below, Applicant traverses this characterization of Mikkelsen.

Mikkelsen does not disclose providing cutting instructions on the sheet with the pictorial image. In fact, Mikkelsen teaches away from this technology in the following quotation from col. 3, lines 48-54:

“The controller has a programmed set of predetermined cutting instructions which includes the reference X and Y coordinates for the registration marks and the predetermined positions thereof with respect to the perimeter of the graphics area when the graphics area and registration marks are first applied to the sheet.” (emphasis added)

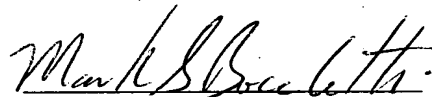
It is clear from the quoted passage, as well as the remainder of the Mikkelsen disclosure, that the only information carried by the sheet is the graphics and a set of registration marks in the vicinity of the graphics intended to be used to detect changes in the dimensions of the sheet between the printing step and the cutting step. Information for cutting the sheets and cutting instructions are found in the controller software, not on the sheets to be cut. Mikkelsen does not enjoy the advantage of having the instructions available to any cutting apparatus to which the sheet is presented as long as the cutting apparatus has the means to decode and use the instructions. In Mikkelsen, a cutter must be programmed with the cutting instructions for each sheet before the sheet can be presented to the cutting apparatus.

The secondary reference to Daly et al. also fails to disclose cutting instructions that are embedded within an image on a sheet to be cut; the same information that is undisclosed by the primary reference to Mikkelsen. Assuming arguendo that the references might be capable of combination, there is at least one limitation in the claimed invention that is not disclosed by the references individually or in combination. “Each element of a claim is material.” *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 USPQ 657,666 (Fed. Cir., 1985)

Claims 2-11, 14-20, 22, 24 and 25 depend directly or indirectly from one of the independent claims discussed above, and are allowable at least for the same reasons. Additional distinctions are present. For example, Claims 3, 10 and 15 call for the cutting information to define a center of the image; not disclosed in the prior art. Claim 4 depends from Claim 3 and further requires that the cutting be external to the image, while Mikkelsen discloses the cutting to be at the edge of the images. Claim 8 calls for automatically positioning the image relative to the cutting mechanism according to the cutting instructions, whereas Mikkelsen positions the cutter relative to a spatially fixed image. Claim 9 sets forth an algorithm not disclosed in the prior art.

For the reasons set forth above, it is believed that the application is in condition for allowance prompt notice of which is earnestly solicited. Accordingly, reconsideration and favorable action are respectfully requested. If, contrary to expectations, questions remain, the Examiner is invited to call the undersigned in order to advance prosecution of the application towards allowance.

Respectfully submitted,



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